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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/790,987	03/02/2004	Csaba Truckai	DFINE.034CP1	1287
20995 7590 11/04/2008 KNOBBE MARTENS OLSON & BEAR LLP 2040 MAIN STREET FOURTEENTH FLOOR IRVINE, CA 92614				
EXAMINER YOON, TAE H				
ART UNIT 1796		PAPER NUMBER		
NOTIFICATION DATE 11/04/2008		DELIVERY MODE ELECTRONIC		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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Office Action Summary

Application No.

10/790,987

Applicant(s)

TRUCKAI, CSABA

Examiner

Tae H. Yoon

Art Unit

1796

Period for Reply -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 04 September 2008.
2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10, 15-19, 21, 23-28 and 36-39 is/are pending in the application.
4a) Of the above claim(s) 21, 23-28 and 36-39 is/are withdrawn from consideration.
5) ☒ Claim(s) 15-19 is/are allowed.
6) ☒ Claim(s) 8-10 is/are rejected.
7) ☐ Claim(s) _____ is/are objected to.
8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____

Newly submitted and amended claims 21, 23-28 and 36-39 directed to an invention that is independent or distinct from the invention originally claimed for the following reasons: Had applicant presented said claims earlier, said claims would have been restricted as following;

1. Claims 21 and 23-28 are directed to making microshells by mixing a polymer, a biocompatible filler and an electrically conductive filler, and the examined claims 15-19 are directed to a composition (without an electrically conductive filler). Thus, it would have a relationship of product (claims 15-19) and process of making (claims 21 and 23-28). Also, the scope of the examined claim 21 is completely different from that of the instant claim 21.

2. Claims 35-39 are directed to making a composite by mixing a polymer and three different fillers, and the examiner claims 8-10 are directed to a composition comprising two different fillers. Thus, it would have a relationship of product (claims 8-10) and process of making (claims 36-39).

3. Said claims 21 and 23-28, and claims 36-39 would have a relationship of subcombination and combination since the second dispersible filler of claim 36 is not needed in claim 21 and forming of microshells of claim 21 is not needed in claim 36.

4. Furthermore, applicant states that new claim 21 is supported by the claim 15, but the examiner disagrees with applicant since said claim 15 does not contain an electrically conductive filler of claim 21. Thus, claim 21 also contains new matter.

Since applicant has received an action on the merits for the originally presented invention, this invention has been constructively elected by original presentation for

prosecution on the merits. Accordingly, claims 21, 23-28 and 36-39 are withdrawn from consideration as being directed to a non-elected invention. See 37 CFR 1.142(b) and MPEP § 821.03.

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

This is NEW MATTER rejection.

Applicant failed to point out support for the recited new limitation of claim 8. Applicant points to pages 25 and 29 for newly recited limitation of claims 9 and 10, but the disclosure in said pages do not support following limitations;

1. There is no teaching with respect to "configured to cooperate with a selected wavelength of light" and "raises the temperature of at least a portion of the base polymer component above its melting temperature" in claim 9. Also, said above its melting temperature encompasses, for example, 50°C above melting point which does not have support.

2. Only support for claim 10 would be in page 31 (the pointed page 29 does not teach light reflecting filler), "In another embodiment, the polymer can carry light-reflecting filler particles for reflecting light energy of selected wavelength. Thus, the nerve bundle of Fig. 18B can be protected when light energy is used to thermally treat adjacent tissue" which hardly supports the recited limitation.

In summary, a brief, general disclosure does not support the recited particular limitation.

Claims 8-10 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Applicant failed to disclose new limitations adequately.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 8-10 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The newly recited limitations lack antecedent basis in original specification and thus claims are indefinite.

The recited "sufficient concentration" in claim 8 is indefinite with respect to amount since the upper limit of the raised temperature is open and since temperature raise is also dependent on the power of the magnetic field which is not recited.

The recited "configured to cooperate" in claim 9 is indefinite since no particular configuration for cooperation is disclosed.

The recited "configured to reflect" in claim 10 is indefinite since no particular configuration for reflection is disclosed.

Applicant forgot to underline added limitation in claim 10.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claim 10 is rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Burnell-Jones (US 6,207,077).

Rejection is maintained for reason of record with following response.

Thus, the examiner's position is that a polymer having fillers such as metal powders (col. 15, line 55) and metal and metal-coated fibers (col. 22, line 47 to col. 23,

line 3, such as sliced aluminum-foil ribbons) and metallic flake pigments (col. 25, line 9) taught by Burnell-Jones would meet the invention inherently since said fillers would reflect light. Burnell-Jones teaches employing 5-75% by weight of the filler at col. 15, line 61 which would meet the instant sufficient concentration. Note that new limitation does not have support in specification and thus said 5-75% by weight clearly meets the invention. A recitation of a functional language alone has no probative value when the prior art teaches the same composition.

Claims 8 and 10 are rejected under 35 U.S.C. 103(a) as obvious over Burnell-Jones (US 6,207,077) in view of Salyer et al (US 3,359,145), Chen et al (US 5,811,314).or Tobita (US 2002/0090501 A1).

Rejection is maintained for reason of record with following response.

Burnell-Jones teach employing metal powders, and thus use of ferromagnetic metals of Salyer et al, Chen et al or Tobita in Burnell-Jones would be a *prima facie* obviousness. Contrary to applicant's assertion that the cited art fail to disclose each and every element of claim 8, the rejection meets the claimed composition, a polymer, a dispersed filler and ferromagnetic filler. The newly recited limitation would be inherent property of a polymer containing said ferromagnetic metals.

Claims 9 and 10 are rejected under 35 U.S.C. 102(b) as anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Laughner et al (US 4,983,648).

Rejection is maintained for reason of record with following response.

One example containing cadmium yellow and phthalyl green (chromophore filler) taught by Laughner et al is more than enough to anticipate the invention, and new limitation would be an inherent property. A particular configuration is not taught in specification contrary to applicant's assertion, and applicant failed to show that the composition of Laughner et al does not have the recited properties. A recitation of a functional language alone has no probative value when the prior art teaches the same composition.

Claims 8-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Schleifstein (US 6,241,914) in view of Laughner et al (US 4,983,648) and Takekoshi et al (US 3,833,546).

Rejection is maintained for reason of record with above response.

Claims 15-19 are allowed.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tae H. Yoon whose telephone number is (571) 272-1128. The examiner can normally be reached on Mon-Fri.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, David Wu can be reached on (571) 272-1114. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Tae H Yoon /Tae H Yoon/
Primary Examiner
Art Unit 1796

THY/October 28, 2008